

REMARKS

Favorable reconsideration and allowance of the claims of the present application, as amended herein, are respectfully requested.

In the present Office Action, Claims 1, 4, 5 and 7-9 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 6,458,387 to Scott et al. ("the '387 patent) as evidenced by WO 2000/0005307 whose English equivalent is U.S. Patent No. 6,624,210 ("the '210 patent).

Concerning the § 102(b) rejection, it is axiomatic that anticipation under § 102 requires that the prior art reference disclose each and every element of the claim to which it is applied. In re King, 801 F.2d, 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Thus, there must be no differences between the subject matter of the claim and the disclosure of the prior art reference. Stated another way, the reference must contain within its four corners adequate direction to practice the invention as claimed. The corollary of the rule is equally applicable: Absence from the applied reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

In response to the above-described § 102(b) rejection, applicants have amended Claim 1 in a manner as indicated in the above. Support for the amendment to Claim 1 can be found at page 8, paragraphs [0040] to [0042] of the originally filed application. Since the amendment does not introduce new matter into the originally filed application, entry thereof is respectfully requested.

In view of the above-described amendment, applicants submit that the claims of the present application, as amended herein, are not anticipated by the disclosure of the '387 patent. Specifically, the microspheres recited in the '387 patent require the presence of a

carrier material, for example, a carrier protein. See column 3, lines 27–30, lines 51-55, and column 42, line 48. In contrast, the microcapsules claimed in the present application are free from carrier materials. In this regard, applicants observe that the microspheres recited in the ‘387 patent are formed by contacting the carrier material with a polymer wherein the carrier material has a primary function to provide a three dimensional structure which stabilizes the formation of the microspheres. Furthermore, such microspheres require a further step of stabilizing by contacting with a crosslinking agent. See column 3, lines 30-44; column 15, line 48-57; and column 42, lines 46-59.

The foregoing remarks clearly demonstrate that the applied reference does not teach each and every aspect of the claimed invention, as required by King and Kloster Speedsteel; therefore the claims of the present application are not anticipated by the disclosure of the ‘387 patent. Applicants respectfully submit that the instant § 102 rejection has been obviated and withdrawal thereof is respectfully requested.

Furthermore, in the present Office Action, Claims 2, 3, 6 and 10 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the ‘387 patent in view of Japanese Patent Application JP 07096166 A (“the ‘166 patent application”).

In response, applicants submit that the claims of the present invention, as amended herein, are not rendered unpatentable by the disclosure of the ‘387 patent in view of the ‘166 patent application since the applied references, either solely or combined, fail to teach or suggest the cosmetic preparation as claimed in the present invention.

Specifically, as discussed above, the ‘387 patent teaches away from the present invention since it requires the presence of a carrier material in the formation of the microspheres, which is contrary to what is claimed in the present invention. With respect to

the secondary reference, the '166 patent application discloses a cosmetic preparation wherein porous fine particles, other than copolymers, are required in the preparation of the microcapsules. See page 2, paragraphs [0009] and [0012]; and page 3, paragraph [0023]. Therefore, the applied secondary reference also teaches away from the present invention because the microcapsules recited in the present invention are free from porous materials. See page 1, paragraph [0001].

Moreover, applicants submit that the combination of the cited references at most teaches a microcapsules wherein porous and carrier materials are present, which is completely opposite to the present invention wherein the microcapsules are free from porous and carrier materials.

Furthermore, even assuming the cited references present a prima facie case of obviousness, which is simply not true, that case can be rebutted by a showing of unexpected results. To that end, applicants observe that they have made several surprising finds for the present claimed cosmetic preparation. Specifically, the microcapsules, which are free from porous and carrier materials, eliminate the remaining residues of hard core materials on the skin which can impair the physiological compatibility or bring about cosmetically undesired effects, and thus provide more pleasant feel on the skin. Moreover, without using the porous and carrier materials, such microcapsules can have a reduced size and can carry more active ingredients, and thus provide a easier and pleasant cosmetic application on the skin. See page 8, paragraph [0040] to [0042]. As such, this showing of unexpected results rebuts any presumption of obviousness created by the cited references.

In view of the above remarks, the conclusion is compelling that the present invention is not obvious over the applied references.

The rejection under 35 U.S.C. §103 has been obviated; therefore reconsideration and withdrawal thereof are respectfully requested.

Thus, in view of the foregoing amendments and remarks, it is firmly believed that the present case is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'LSZ', with a long horizontal flourish extending to the right.

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